OIPE JUL 12 2006 PATENT & TRADEMARK OFFICE

Atty. Dkt. No. 035451-0165 (3703.Palm)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Wong et al.
Title:	OBJECT TAGGING SYSTEM AND METHOD
Appl. No.:	09/998,079
Filing Date:	11/30/2001
Examiner:	Pham, Tuan
Art Unit:	2681
Confirmation No.:	4525

CERTIFICATE OF EXPRESS MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

EV 904367041 US (Express Mail Label Number) 07/12/06 (Date of Deposit)

Roberta A. Cooper (Printed Name)

Roberta A. Cooper (Signature)

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

Mail Stop **APPEAL BRIEF - PATENTS**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is the following document for the above-identified application.

[X] Reply Brief Under 37 C.F.R. § 1.193(b)(1) (6 pages).

Respectfully submitted,

Date 7/12/2006

By Nathaniel St. Clair, II

FOLEY & LARDNER LLP
Customer Number 26371
Telephone: (414) 297-5845
Facsimile: (414) 297-4900

Nathaniel St.Clair, II
Attorney for Applicant
Registration No. 57,498

07-13-06

AF
IFW

Atty. Dkt. No. 035451-0165 (3703.Palm)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Wong et al.
Title:	OBJECT TAGGING SYSTEM AND METHOD
Appl. No.:	09/998,079
Filing Date:	11/30/2001
Examiner:	Pham, Tuan
Art Unit:	2681
Confirmation No.:	4525

CERTIFICATE OF EXPRESS MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

EV 904367041 US (Express Mail Label Number) 07/12/06 (Date of Deposit)

Roberta A. Cooper
(Printed Name)

Roberta A. Cooper
(Signature)

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

Mail Stop **APPEAL BRIEF - PATENTS**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the May 12, 2006 Examiner's Answer to the Appellant's Appeal Brief (hereinafter referred to as the "Examiner's Answer"), the following additional remarks are submitted.

Response to Argument

I. REJECTION OF CLAIMS 1, 3, 7-11, 13, 16, 18-21, 23, 26, AND 28-29 UNDER 35 U.S.C. § 103(a) BASED ON ALBUKERK ET AL. IN VIEW OF COLSON ET AL.

As indicated by the Appellant's Brief on Appeal dated February 21, 2006 (hereinafter referred to as the "Appeal Brief"), the Appellant submits that the Examiner has still not shown any suggestion or motivation, or any convincing line of reasoning, for combining the teachings of Albukerk et al. and Colson et al. In the Examiner's Advisory Action dated November 21, 2005, the Examiner suggested that "only the highest priority data is stored on the limited storage resources of the client device as suggested by Colson et al. at column 2, [0012]" would provide motivation to combine the teachings of Albukerk et al. and Colson et al. Thus the Examiner is suggesting that the motivation to combine is "found in the references themselves." (Advisory Action, para. 1.) The Examiner, however, has not pointed to any recognition, express or implied, in either Albukerk et al. or Colson et al. that any such advantage cited in Colson et al. would be produced by the combination of these references. For example, the Examiner has not provided any indication how the teachings of Albukerk et al. or Colson et al. would have to be modified to include the teachings of Colson et al. to achieve such advantages, or how the prioritization system 10 of Colson et al. would work with the teachings of Albukerk et al.

In response to Appellant's arguments, the Examiner indicates that it is well known in the data processing art to "sort[] data in order by giving strong priority to data." (Examiner's Answer, p. 8.) However, Appellant submits that when properly viewed as a whole, Colson et al. teaches the prioritization of data as part of a synchronization process between two devices: (1) a client device (e.g., laptop computer 44, Internet appliance 45, or PDA 46) having a relatively limited storage capacity and (2) a device having a relatively higher data storage capacity (e.g., personal computer 42). See Colson et al., paragraphs [0017], [0026], and [0027]. The client device initiates the synchronization process and receives and stores prioritized data as a subset of

the data stored on the device having a relatively higher data storage capacity, but *does not perform data prioritization.* In Colson et al., the prioritized data is retrieved by the data prioritization system 10 from a copy of the data stored in the device having the relatively higher data storage capacity, or the data prioritization system 10 otherwise communicates with the device having the relatively higher data storage capacity to retrieve the data. See Colson et al., paragraph [0032]. Thus, the way Colson et al. teaches "how to process the priority data" requires a separate data prioritization system 10 to implement a synchronization process between the client device and the device with a relatively higher data storage capacity, which is inherently teaching away from the subject matter of the claims.

Thus, Colson et al., when viewed as a whole, teaches away from a process of prioritizing data stored on a portable electronic device using the portable electronic device to prioritize its own data, as set forth in the claims. Contrary to the Examiner's suggestions, one of ordinary skill in the art following the teachings of Colson et al. and Albukerk et al. would arrive at a process wherein the personal interpretive device 101 initiates a process for synchronization with a data storage device having a relatively higher storage capacity (e.g., the base computer 111 or a remotely situated server 205) using a separate data prioritization system for purposes of prioritizing information each time a different object is approached. Accordingly, one of ordinary skill in the art would not have been motivated to modify the teachings of Albukerk et al. to include the prioritization system of Colson et al. to somehow arrive at the subject matter of the present claims.

In response to the Appellant's arguments regarding hindsight reasoning, the Examiner indicates that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." (Examiner's Answer, p. 9.) However, Appellant submits that the Examiner engaged in hindsight reasoning to combine Albukerk et al. and Colson et al., by utilizing the Appellant's patent application as a road map to support the proposed combination. Accordingly, the Examiner's use of hindsight reasoning for purposes of reconstruction was improper. The Appellant further submits that one of ordinary skill in the art would not have been

motivated to combine the teachings of Albukerk et al. and Colson et al., without such improper hindsight reasoning.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because there is no suggestion or motivation to combine the teachings of Albukerk et al. and Colson et al. and that the rejection of independent claims 1, 11, and 21 should be reversed.

Claims 3 and 7-10 depend from independent claim 1, claims 13, 16, and 18-20 depend from independent claim 11, and claims 23, 26, 28-29 depend from claim 21 and are therefore patentable for at least the same reasons as discussed above. See 35 U.S.C. § 112 ¶ 4. Appellant submits that if independent claims 1, 11, and 21 are novel and non-obvious, the claims that respectively depend therefrom are also novel and non-obvious. Additionally, Appellant respectfully submits that the previously presented dependent claims recite additional novel and non-obvious features which are not taught or suggested by the references.

In view of the foregoing, as well as in view of the Argument set forth in Appellants' Appeal Brief, Appellants submit that claims 1, 3, 7-11, 13, 16, 18-21, 23, 26 and 28-29 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Albukerk et al. and Colson et al. and are therefore patentable.

II. REJECTION OF CLAIMS 4-6, 14-15, 17, 24-25, AND 27 UNDER 35 U.S.C. § 103(a) BASED ON ALBUKERK ET AL. IN VIEW OF COLSON ET AL. AND FURTHER IN VIEW OF SCHULZE ET AL.

As indicated by the Appeal Brief, the Appellant submits that the Examiner has still not shown any suggestion or motivation, or any convincing line of reasoning, for combining the teachings of Albukerk et al. and Schulze et al. In the final Office Action dated September 19, 2005, the Examiner rejected claims 4-6, 14-15, 17, 24-25, and 27 under 35 U.S.C. § 103(a) as

being unpatentable over Albukerk et al. in view of Colson et al. and further in view of Schulze et al. For the reasons stated below, the Examiner's rejection of claims 4-6, 14-15, 17, 24-25, and 27 should be reversed.

A. Claims 4-6

Claims 4-6 depend from claim 1. The combination of Albukerk et al. in view of Colson et al. fails to render the subject matter of claim 1 prima facie obvious. As to Schulze et al., it fails to make up for any of the deficiencies in the combination of Albukerk et al. in view of Colson et al. mentioned above. Because claims 4-6 depend from claim 1, the Examiner's rejection of claims 4-6 should be reversed for at least the same reasons as discussed above with regard to claim 1. See 35 U.S.C. § 112 ¶ 4.

B. Claims 14-15 and 17

Claims 14-15 and 17 depend from claim 11. The combination of Albukerk et al. in view of Colson et al. fails to render the subject matter of claim 11 prima facie obvious. As to Schulze et al., it fails to make up for any of the deficiencies in the combination of Albukerk et al. in view of Colson et al. mentioned above. Because claims 14-15 and 17 depend from claim 11, the Examiner's rejection of claims 14-15 and 17 should be reversed for at least the same reasons as discussed above with regard to claim 11. See 35 U.S.C. § 112 ¶ 4.

C. Claims 24-25 and 27

Claims 24-25 and 27 depend from claim 21. The combination of Albukerk et al. in view of Colson et al. fails to render the subject matter of claim 21 prima facie obvious. As to Schulze et al., it fails to make up for any of the deficiencies in the combination of Albukerk et al. in view of Colson et al. mentioned above. Because claims 24-25 and 27 depend from claim 21, the Examiner's rejection of claims 24-25 and 27 should be reversed for at least the same reasons as discussed above with regard to claim 21. See 35 U.S.C. § 112 ¶ 4.

In view of the foregoing, as well as in view of the Argument set forth in Appellant's Appeal Brief, Appellants submit that claims 4-6, 14-15, 17, 24-25, and 27 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Albukerk et al., Colson et al., and Schulze et al. Accordingly, Appellant respectfully requests that the Board reverse all claim rejections and indicate that a notice of allowance respecting all pending claims should be issued.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date 7/12/2006

By _____

FOLEY & LARDNER LLP
Customer Number 26371
Telephone: (414) 297-5845
Facsimile: (414) 297-4900

Nathaniel St.Clair, II
Attorney for Applicant
Registration No. 57,498